

**REMARKS****Summary of the Office Action**

The Office Action points out what it refers to as a minor error in claim 10, line 14 and requests that any additional “minor errors” in the specification that Applicant may be aware of be corrected.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,815,486 to Kobayashi et al. (hereinafter “Kobayahsi”) in view of U.S. Patent No. 5,559,784 to “Ota”.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayahsi in view of Ota as applied to claim 10, and further in view of U.S. Patent No. 5,808,988 to Maeda et al. (hereinafter “Maeda”).

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayahsi in view of Ota as applied to claim 10, and further in view of JP 2000339694A to “Masui”.

Claim 14, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

Claims 1-9 are withdrawn from consideration as being drawn to a nonelected invention.

**Summary of the Response to the Office Action**

Applicant has amended claim 10 to improve the form of the claim. Claims 1-14 are currently pending, with claims 10-14 currently under consideration.

**Various Formality Issues and Objection to the Specification**

The Office Action points out what it refers to as a minor error in claim 10, line 14 and requests that any additional “minor errors” in the specification that Applicant may be aware of be corrected.

In response, Applicant has amended claim 10, line 14 to replace “pre-pits” with \ --pre-pit-- in the manner suggested by the Examiner. In addition, Applicant has implemented numerous amendments to the specification to improve its readability including the following changes: 1) replacing “doubly-layer” with --double-layer-- at page 1, line 22; and 2) replacing “pre-pits” with --pre-pit-- at lines 9, 12 and 13 of page 5; line 15 of page 6; line 27 of page 7; lines 6 and 21-22 of page 9; lines 10 and 22 of page 13; line 11 of page 14; line 25 of page 15; lines 5, 12 and 16 of page 16; lines 18, 20 and 22 of page 17; lines 6, 7 and 26 of page 18; line 4 of page 19; line 26 of page 24; line 3 of page 33; and line 13 of the Abstract at page 41.

Accordingly, Applicant respectfully submits that all outstanding formality issues have been addressed. Withdrawal of the associated objection to the specification is thus respectfully requested.

**The Rejections under 35 U.S.C. § 103(a)**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayahsi in view of Ota. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayahsi in view of Ota as applied to claim 10, and further in view of Maeda. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayahsi in view of Ota as applied to claim 10, and further in view of Masui. These rejections are respectfully traversed for at least the following reasons.

The embodiment of the present application's invention, as recited in claim 10, defines a circuit for generating a recording mark signal for recording a recording mark of a predetermined length in each of said pre-pit regions while the beam of light is irradiated on the pre-pit region.

The Office Action applies Kobayashi as allegedly teaching a recording apparatus in Fig. 10 that includes a "circuit for generating a recording mark signal (figure 9, element 23) for recording a recording mark of a predetermined length in pre-pit regions while the beam of light is irradiated on the pre-pit regions."

Applicant respectfully submits that col. 5, lines 60-62 of Kobayashi describe that a "mark signal generating circuit 23 generates a mark signal at the timing of forming a synchronizing mark is formed, and outputs it to the combining circuit 22." As illustrated in Fig. 5 of Kobayashi, a fine clock mark is formed in a synchronizing mark area 12 provided in a wobble address frame which includes 84 channels. Data of 84 channels is recorded in each channel having seven carriers. Thus, one frame has 588 carriers (84x7) in total.

As described at col. 4, lines 54-65 of Kobayashi, data is recorded at a cycle of seven channels. The first channel of the seven channels corresponds to seven carriers including a fine clock mark. The other six channels correspond to an interval modulated by substantial address data that does not include any fine clock mark.

In the optical disc recording/reproducing apparatus shown in Fig. 10 of Kobayashi, a mark detection circuit 36 detects a component corresponding to the fine clock mark from an RF signal reproduced by an optical head 32. As described at col. 6, lines 60-63 of Kobayashi, a "mark period detection circuit 40 determines whether detection pulses outputted by the mark detection circuit 36 when detects the fine clock mark have periodicity. In other words, the fine

clock mark is generated in a constant period.” Thus, as described in Kobayashi, the fine clock mark is provided in the synchronizing mark area in a wobbled groove, to realize “an apparatus and a method for rapidly recording data on the disc or rapidly reproducing data from the disc,” as discussed in col. 1 of Kobayashi.

Claim 10 of the present application specifically recites that the recording apparatus includes a circuit for generating a recording mark signal for recording a pit region. Claim 10 additionally recites that the average reflectance of the rewritable regions is different from average reflectance of the pre-pit regions.

Accordingly, claim 10 recites a combination that includes, amongst other features, a recitation that the recording mark signal is a signal for recording a recording mark of a predetermined length in each of said pre-pit regions which have an average reflectance that is different from that of the rewritable regions.

In light of the recitations of claim 10 which include at least the definition of “recording mark,” as mentioned above, Applicant respectfully submits that the subject matter of claim 10 would not be obtained even assuming, strictly arguendo, that the Office Action’s applied combination of Ota with Kobayashi was proper because neither of these references, whether taken separately or in combination, teach or suggest such features.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither Kobayahsi nor Ota, whether taken singly or combined, teach or suggest each feature of independent claim 10, as discussed above. MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Furthermore, Applicant respectfully asserts that dependent claims 11-13 are allowable at least because of their dependence from claim 10, and the reasons set forth above. Moreover, with regard to the rejections of dependent claims 11-13 under 35 U.S.C. § 103(a), Applicant respectfully submits that the additionally applied references to Maeda and Masui do not cure the deficiencies of Kobayashi and Ota, as discussed above. Accordingly, withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

The Examiner is thanked for the indication that claim 14, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form. However, in light of the foregoing discussion, Applicant respectfully submits that claim 14 is in condition for allowance at least because of its dependence on independent claim 10, and the reasons set forth above. Accordingly, withdrawal of the objection to claim 14 is respectfully requested.

### **Conclusion**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of all rejections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under

37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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